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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LEE E. CANNON, MIKE MARONEY, ROBERT GUINN,  
MICK D. ROEMER, WILLIAM R. ADAMS, and  
JASON DEGRANDMAISON

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Appeal 2011-002969  
Application 09/655,252  
Technology Center 3700

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Before JENNIFER D. BAHR, LINDA E. HORNER, and  
PATRICK R. SCANLON, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Lee E. Cannon et al. (Appellants) seek our review under 35 U.S.C.  
§ 134 of the Examiner's decision rejecting claims 48-50, 54, 55, 57-84, and

90-126. Claims 1-47, 51-53, 56, and 85-89 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

#### THE INVENTION

Appellants' claimed invention "relates to methods and apparatus for providing tickets from games of chance, such as gaming devices and from lottery terminals." Spec. 2, para. [0001].<sup>1</sup> Claims 48 and 116, reproduced below, are representative of the subject matter on appeal.

48. A gaming device comprising:

a currency receiver being adapted to receive at least one medium of currency;

a display device being adapted to display indicia corresponding to an outcome of a wagering game, the outcome of an occurrence of the wagering game being at least partially randomly determined;

a first output device adapted to dispense a gaming award based on the occurrence of a predetermined winning outcome or cumulative result of a plurality of outcomes during the occurrence of the wagering game after depositing at least a minimum amount of the at least one medium of currency in the currency receiver; and

a second output device adapted to dispense a ticket that is not a gaming award after the occurrence of a triggering event, wherein the triggering event is not the occurrence of a predetermined winning outcome or a cumulative result of a plurality of winning outcomes of the wagering game, and wherein the triggering event is not every occurrence of the wagering game.

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<sup>1</sup> "Spec." refers herein to the Substitute Specification filed January 29, 2002.

116. A method of conducting a wagering game on an electronic gaming device comprising the steps of:

providing a player with an opportunity to place a wager and to play the wagering game at the wagering device, wherein the outcome of each occurrence of the wagering game is at least partially randomly determined;

accumulating comp points for the player as the player plays the wagering game wherein the comp points are determined independent of the outcome of the randomly determined wagering game and the skill of the player;

displaying a visible indication of the player's accumulated comp points at the gaming device; and

providing the player with the opportunity to redeem at least a portion of the accumulated comp points at the gaming device via an input device.

#### THE EVIDENCE

The Examiner relies upon the following evidence:

Mullins	US 5,158,293	Oct. 27, 1992
Deaton	US 5,621,812	Apr. 15, 1997
Boushy	US 5,761,647	Jun. 2, 1998
Baerlocher	US 5,788,573	Aug. 4, 1998
Kelly	US 5,816,918	Oct. 6, 1998
Harrison	US 5,934,671	Aug. 10, 1999
Harlick	US 5,941,773	Aug. 24, 1999

### THE REJECTIONS

Appellants seek review of the following rejections:<sup>2</sup>

1. Claims 48-50, 54, 55, 59-63, 78-84, 92-97, and 111-122 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kelly and Deaton.
2. Claims 57, 58, 90, and 91 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kelly, Deaton, and Harlick.
3. Claims 64 and 98 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kelly, Deaton, and Harrison.
4. Claims 65, 66, and 99 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kelly, Deaton, and Baerlocher.
5. Claims 67-77 and 100-110 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kelly, Deaton, and Mullins.
6. Claims 123-126 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kelly, Deaton, and Boushy.

The Examiner also provisionally rejected claims 48-50, 54, 55, 57-84, and 90-126 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-48 of co-pending Application 10/353,689. Appellants do not seek review of this rejection. App. Br. 4-5. Since the filing of the Examiner's Answer, the applicants in Application

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<sup>2</sup> In Section II of their Appeal Brief, Appellants directed our attention to related appeal 2007-3865 in Application 10/353,689, which presented "similar issues on appeal regarding rejections in view of the same prior art." App. Br. 2. In the related appeal, the Board affirmed a rejection based on Kelly (US 5,816,918, iss. Oct. 6, 1998) in view of Deaton (US 5,642,485, iss. Jun. 24, 1997) and reversed a rejection based on Kelly in view of Degasperri (US 5,097,981, iss. Mar. 24, 1992).

10/353,689 canceled claims 1-6 and 8-48 and the application issued as U.S. Patent 7,686,687 on March 30, 2010 with application claim 7 becoming patented claim 1. Because the circumstances surrounding the co-pending ‘689 application have changed since institution of the double patenting rejection in the instant ‘252 application, we decline to reach this rejection, and leave it to the Examiner to determine whether the obviousness-type double patenting rejection is proper in light of the issued claim of the ‘687 patent.

### ISSUES

The issues presented by this appeal are:

Did the Examiner articulate adequate reasoning based on rational underpinnings to explain why one of ordinary skill would have been led to modify the system of Kelly with the teachings of Deaton to result in the gaming device of claim 48?

Did the Examiner adequately show how the combined teachings of Kelly and Deaton would have led one of ordinary skill in the art to the method of claim 116?

### FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Kelly discloses a prize redemption system and method for use with a game apparatus that allows players to win “prize credits” and/or specific prizes by playing the game apparatus (Kelly, col. 2, ll. 62-67).

2. Kelly discloses a game unit 10 having a monetary input device 14 for receiving a wager, input devices 16 used by a player to play the game, and both a universal ticket dispenser 20 and a specific prize ticket dispenser 22 (Kelly, col. 6, ll. 10-14).
3. The universal ticket dispenser 20 dispenses universal ticket vouchers, which are generic and not specific to any prize and which can be accumulated by a player and used to redeem one or more of several available prizes (Kelly, col. 8, ll. 32-43 and 54-58).
4. A prize can be a promotional coupon, which can encourage players to return to the current gaming environment or location more quickly in the future (Kelley, col. 8, ll. 61-63).
5. The specific prize ticket dispenser 22 dispenses specific prize tickets which can be used in the gaming environment to redeem a particular prize or type of prize that a player can be directly and immediately awarded due to a particular winning result on game unit 10 (Kelly, col. 9, ll. 1-4 and 42-50).
6. Kelly discloses that a player may win both a specific prize ticket and prize credits during a game (Kelly, col. 26, ll. 44-45).
7. Kelly discloses that universal and specific prize tickets are dispensed upon a successful outcome of the game (i.e., as prizes), and thus these tickets are gaming awards. Kelly does not disclose dispensing a ticket that is not a gaming award.
8. Deaton discloses a system designed to improve a store's marketing and other customer relations programs by collecting transaction data

for that store that can be used to identify new or infrequent customers, develop customer profiles, and perform targeted marketing (Deaton, col. 3, ll. 61-65).

9. Deaton discloses that the system provides automatic targeting of individual customers based upon their shopping history, such that at the point-of-sale, it dispenses coupons or other incentives specifically targeted to a specific customer (Deaton, col. 64, ll. 41-45 and 50-53; col. 66, ll. 35-37; col. 66, l. 65 – col. 67, l. 1; figs. 17A, 17B).
10. For example, substantial rewards may be given to an infrequent shopper, while less substantial rewards may be given to a more frequent shopper (Deaton, col. 64, ll. 54-64).
11. As such, Deaton discloses a targeted marketing technique designed to encourage infrequent shoppers to become more frequent patrons of a store or other establishment by dispensing tickets (i.e., coupons) based on the customer's patronage of the establishment (Deaton, col. 67, ll. 19-27).
12. Deaton's tickets are not gaming awards because they are not provided to a patron based on the outcome of a game played on a gaming device.
13. Neither Kelly nor Deaton discloses or suggests displaying a visible indication of accumulated comp points or allowing a customer to redeem comp points at a gaming device.



## ANALYSIS

### *Rejection based on Kelly and Deaton*

Appellant argues claims 48-50, 54, 55, 59-63, 78-84, 92-97, and 111-115 as a first group. App. Br. 5-9. We select claims 48 as representative of the group. See 37 C.F.R. § 41.37(c)(1)(vii) (2011). We address claims 116-122 separately *infra*.

Appellants do not contest the Examiner's findings as to the scope and content of Kelly and Deaton or as to the differences between the prior art and the invention of claim 48. App. Br. 6-8. Rather, Appellants take issue with the Examiner's combination of the references. App. Br. 8-9. In particular, Appellants argue that Kelly provides "no clear and particular actual evidence of a suggestion or motivation for dispensing tickets that are not gaming awards from a gaming unit, and in fact teaches away from doing so by disclosing the awarding of many different types of prizes, including goods and services, as game awards." App. Br. 7. We agree with Appellants that Kelly does not provide an explicit suggestion to dispense tickets that are not gaming awards from a gaming unit. FF 7. The fact, however, that Kelly fails to provide an explicit teaching does not end our inquiry, because the rejection was based on obviousness in view of the combination of Kelly and Deaton, in which the Examiner relied on Deaton for the disclosure of dispensing tickets that are not gaming awards.

As to the Appellants' assertion that Kelly teaches away from dispensing tickets that are not gaming awards, we disagree. "A reference may be said to teach away when a person of ordinary skill, upon reading the

reference would ... be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (quoting *Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999)). Kelly’s disclosure of gaming awards does not discourage and would not have led one of ordinary skill away from dispensing tickets that are not gaming awards, in addition to dispensing gaming awards. Rather, as noted by the Examiner, Kelly teaches that a prize can be a promotional coupon, which can encourage players to return to the current gaming environment or location more quickly in the future. FF 4. As such, Kelly is clearly concerned with encouraging players to visit a gaming establishment more frequently. Kelly’s objective can be achieved equally well by giving players tickets (such as promotional coupons) to encourage their return to the gaming establishment even if the players are not successful at the game at the time they receive the ticket, i.e., so that the tickets are not “gaming awards” because they are not the result of a successful outcome to the game. Thus, we do not agree that Kelly’s omission of a teaching of dispensing non-gaming award tickets constitutes a teaching away from such.

Appellants argue that Deaton “contains no disclosure or suggestion of implementing its system in gaming units or in a gaming environment and, therefore, provides no clear and particular actual evidence of a suggestion or motivation for dispensing coupons from a gaming unit in addition to the game awards dispensed by the gaming unit as recited in the claims.” App. Br. 7-8. Even if we were to agree with Appellants that Deaton does not

suggest dispensing tickets from a gaming unit, that fact does not end our inquiry, because the rejection was based on obviousness in view of the combination of Kelly and Deaton, in which the Examiner relied on Kelly for the disclosure of dispensing tickets from a gaming unit.

Appellants further assert that the Examiner's rejection fails because the Examiner has not provided "actual evidence of the suggestion or motivation to combine the particular references." App. Br. 8. Although it is important for the Examiner to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), made clear that there is no requirement for an actual teaching, suggestion, or motivation in the references themselves to combine. *Id.* at 419 ("Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the [teaching-suggestion-motivation] test is incompatible with our precedents."). The Court explained that "[c]ommon sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420.

The Examiner found that Kelly teaches the gaming device and method as claimed except that Kelly dispenses a ticket that "may be considered to be a gaming award." Ans. 5. We agree with the Examiner's findings. FF 1-7. The Examiner found that Deaton teaches a device for providing a ticket to a patron to reward frequent customers or to encourage infrequent customers to

be frequent customers and that Deaton's ticket is not a gaming award.

Ans. 5. Again, we agree with the Examiner's findings. FF 8-12. The Examiner concluded that it would have been obvious to modify Kelly in view of Deaton to issue tickets that are not a gaming award upon the occurrence of a triggering event that is not the occurrence of a predetermined winning outcome of a wagering game or the cumulative result of a plurality of outcomes or every transaction (i.e., every occurrence of the wagering game) in order to encourage the player to return to the current gaming location in the future. Ans. 5. The Examiner reasoned that because both Deaton and Kelly are concerned with the same problem of "encouraging customer loyalty" (*see* FF 4 & 11) and because Deaton is "exactly analogous to the casino comps programs that were in existence at the time of the invention," one of ordinary skill in the art would have been motivated to look to Deaton for ways to improve customer loyalty, and would have been led to modify Kelly by issuing tickets that are not gaming awards, as taught in Deaton. Ans. 14-15.

We find no error in this conclusion of obviousness. The Examiner provided an explanation of this reasoning with a rational underpinning to support the legal conclusion of obviousness. We agree that the application of Deaton's targeted marketing technique of dispensing coupons based on a customer's patronage to the system of Kelly to provide an added customer incentive would have been a predictable variation of Kelly's system in order to perform the same function and achieve the same goal, i.e., customer loyalty. *See KSR*, 550 U.S. at 417 ("if a technique has been used to improve

one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill”).

Appellants, rather than take issue with the Examiner’s reasoning, merely argue the references individually and assert that because neither reference suggests what is taught by the other, there would have been no motivation to combine. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). As such, we sustain the rejection of claims 48-50, 54, 55, 59-63, 78-84, 92-97, and 111-115 under 35 U.S.C. § 103(a) as unpatentable over Kelly and Deaton.

Independent claim 116 is directed to a method of conducting a wagering game on an electronic gaming device. The Examiner found:

Kelly teaches accumulating points for the player as the player plays the wagering game and displaying a visible indication (125) of the player’s accumulated points at the gaming device and providing the player with the opportunity to redeem at least a portion of the accumulated points at the gaming device via an input device. (Abstract)[.] Kelly also teaches that the gaming device may be used for promotional uses – i.e., comps. (Col 6, 61-63)[.] In that situation, the points accumulated by the player would be comp points.

Ans. 7-8.

We agree with Appellants (App. Br. 11, Reply Br. 1-3) that Kelly’s disclosure of promotional coupons are in the context of prize awards and Kelly does not disclose comps or the accumulation, display, and redemption

of comp points. FF 4. As such, the Examiner has failed to adequately articulate how the combined teachings of Kelly and Deaton would have led one of ordinary skill in the art to a method that includes the steps of displaying accumulated comp points at a gaming device and allowing a player to redeem the comp points at the gaming device as called for in claim 116. While Deaton teaches accumulation of comp points, i.e., awarding complementary awards based on a customer meeting certain criteria, FF 11, Deaton does not suggest displaying the accumulation of comp points to the customer or allowing a customer to redeem the comp points using an input device. FF 13. As such, absent impermissible hindsight, we fail to see how the combined teachings of Kelly and Deaton would have led one of ordinary skill in the art to the method of claim 116. Accordingly, we do not sustain the rejection of claim 116, or its dependent claims 117-122, under 35 U.S.C. § 103(a) as unpatentable over Kelly and Deaton.

*Rejections of Claims 57, 58, 64-77, 90, 91, and 98-110*

Appellants argue that the Examiner erred in rejecting claims 57, 58, 64-77, 90, 91, and 98-110 for the same reasons presented for patentability of claim 48, and because the tertiary references relied upon in these rejections, i.e., Harlick, Harrison, Baerlocher, and Mullins, fail to cure the asserted deficiencies in the combination of Kelly and Deaton. App. Br. 10-11. Finding no deficiency in the Examiner's combination of Kelly and Deaton as it pertains to claim 48, we sustain the rejections of claims 57, 58, 64-77, and 98-110 for the same reasons provided *supra* for claim 48.

*Rejection of claims 123-126*

The Examiner relied on Boushy to disclose “accumulating a plurality of comp values according to different comp criteria.” Ans. 12. The Examiner does not rely on Boushy to disclose displaying a visible indication of a player’s accumulated comp points at the gaming device or providing the player with the opportunity to redeem at least a portion of the accumulated comp points at the gaming device via an input device. As such, the Examiner does not rely on Boushy to cure the above-noted deficiencies in the combination of Kelly and Deaton with regard to independent claim 116. Accordingly, we cannot sustain the Examiner’s rejection of dependent claims 123-126 under 35 U.S.C. § 103(a) based on Kelly, Deaton, and Boushy.

CONCLUSIONS

The Examiner articulated adequate reasoning based on rational underpinnings to explain why one of ordinary skill would have been led to modify the system of Kelly with the teachings of Deaton to result in the gaming device of claim 48.

The Examiner did not adequately show how the combined teachings of Kelly and Deaton would have led one of ordinary skill in the art to the method of claim 116.

DECISION

We AFFIRM the decision of the Examiner to reject claims 48-50, 54, 55, 57-84, and 90-115 based on the cited prior art. We REVERSE the decision of the Examiner to reject claims 116-126 based on the cited prior

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art. We do not reach the merits of the rejection of all the pending claims based on obviousness-type double patenting.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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